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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,832	06/25/2001	John Ruckart	60027.0002US01/BS00375	9399

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
2645	11

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/888,832

**Applicant(s)**

RUCKART, JOHN

**Examiner**

Ovidio Escalante

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 30-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 30-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This action is in response to applicant's amendment filed on January 20, 2004. Claims 1-10 and 30-50 are now pending in the present application.

#### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 46 is rejected under 35 U.S.C. 102(a) as being anticipated by gwmizer@bellsouth.net, Projected Caller ID, (hereinafter gwmizer).

*Regarding claim 46*, gwmizer teaches a method of proving visual caller identification, (projected caller ID; see description of eBay item), comprising the steps of:

receiving a call at a caller identification device, (see description of eBay item); and  
projecting information (phone caller ID) about the call through a projection orifice (LCD laser light orifice or lens orifice) in the caller identification device and onto a projection surface, (remote surface, e.g. wall, ceiling or small screen; see description).

4. Claims 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Shnier US Pub. 2002/0009184.

*Regarding claims 48 and 50*, Shnier teaches a caller identification device and a method for providing visual caller identification (paragraphs 87 and 89) comprising:

circuitry, (fig. 1), operative to receive a call, (paragraphs 80-83);  
to receive caller identification information associated with the call, (paragraph 87 and 88);  
to store a plurality of directory numbers, (paragraphs 87 and 88);

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to compare the directory number associated with the call with the plurality of directory numbers, (paragraphs 93 and 94);

if one of the plurality of directory numbers matches the directory number associated with the call, to display a first visual identification indicatory, and to display the caller identification information associated with the call, (paragraphs 54 and 101; LED 201 “recognized” is illuminated and the caller name and number is displayed);

if one of the plurality of directory numbers does not match the directory number associated with the call, to display a second visual identification indicatory, and to display the caller identification information associated with the call, (paragraphs 54 and 98; LED 202 “unrecognized” is illuminated); and

if no caller identification information associated with the call is location , to display a third visual identification indicatory, and to display a message that no caller identification information associated with the call is available, (paragraphs 35 and 93; LED 203 “unavailable” is illuminated and the standard caller ID identifier “private” or “out of area” is displayed).

***Regarding claim 49***, Shnier teaches wherein the circuitry comprises a microprocessor and associated programming, (paragraph 81).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 34 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabkel US Patent 5,999,613 in view of Shnier US Pub. 2002/0009184.

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***Regarding claims 1,34 and 45***, Nabkel teaches a method for providing visual caller identification in an Advanced Intelligent Network, (col. 3, lines 45-48,54-59), including a switch (SSP; col. 4, lines 7-18), a service control point (SCP; col. 4, lines 20-29) and a database of caller identification information, (col. 5, lines 13-19), wherein the service control point is functionally connected to the switch, (fig. 3), and wherein the method comprises the steps of:

receiving a call from a calling party at a calling party switch directed to a called party at a called party switch, (col. 4, line 66-col. 5, line 2; fig. 3);

sending call information associated with the caller to the service control point, (adjunct processor/software module 12; col. 3, lines 65-67), the call information including the directory number of the calling party, (col. 5, lines 13-19);

at the service control point, (SCP), query the database of caller identification information for caller identification information associated with the caller, (col. 5, lines 19-24);

sending the caller identification information to a called party caller identification device via the called party switch, (col. 3, lines 44-48; the subscriber's device receives a visual indicator information); and

comparing the directory number of the calling party with the one or more directory numbers saved by the called party, (col. 5, lines 19-24).

Nabkel does not specifically teach of displaying different visual identification indicators based upon the received caller identification information.

Shnier teaches a method of providing visual caller identification, (paragraph 89; fig. 3; LEDs 201,202, and 203 show whether the caller ID information had a reason code).

Shnier further teaches that it was well known in the art to have receive caller ID information and if one of the directory numbers saved by the called party matches the directory number of the calling party, displaying a first visual identification indicator, and displaying the caller identification information associated with the call, (paragraphs 54 and 101; LED 201 “recognized” is illuminated and the caller name and number is displayed);

if one of the directory numbers saved by the called party does not match the directory number of the calling party, displaying a second visual identification indicator, and displaying the caller identification information associated with the call, (paragraphs 54 and 98; LED 202 “unrecognized” is illuminated); and

if no caller identification associated with the call, displaying a third visual identification indicator, and displaying a message that no caller identification information associated with the call is available, (paragraphs 35 and 93; LED 203 “unavailable” is illuminated and the standard caller ID identifier “private” or “out of area” is displayed).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nabkel by displaying three different visual indicators based upon the received caller ID as taught by Shnier so that a user can decide, based on illuminating lights and without having to go to read a display, whether to answer a call.

7. Claims 2-10 and 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabkel in view of Shnier and further in view of Lee et al. US Pub. 2002/0183098.

***Regarding claims 2,5,8,31-33,35,38 and 41***, Nabkel in view of Shnier, as applied above, teach displaying a first and second visual identification indicator and displaying the caller identification information associated with the call and displaying a third visual identification

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indicator, and displaying a message that no caller identification information associated with the call is available. While Nabkel and Shnier further teach illuminating at least a first, second and third LEDs to indicate various information of the caller ID, Nabkel and Shnier do not specifically teach whether or not the LEDs are the same or different colors and thus does not teach of having three different colored LED lights. However, the Examiner notes that it would have been obvious to one of ordinary skill in the art that the LEDs of Shnier would be at least a first color and thus will illuminate a first colored light since all LEDs light up a translucent color casing around the diode components.

Lee teaches of a telephone device which is capable of receiving an incoming caller ID and wherein the device is capable of illuminating a first, second, and third colored light or flashing a light according to a first, second and third flashing sequence, (paragraphs 8 and 18), and displaying the caller identification information on a readable display screen of the caller identification device, (fig. 1). Lee teaches that the LED illuminates or flash based upon predetermined criteria such as who is calling. One of ordinary skill in the art would have been motivated to modify the system of Nabkel and Shnier to use three different colors to represent the three different incoming call types so that the incoming call can be more attractive, (paragraph 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Shnier by illuminated and flashing different color LEDs as taught by Lee so that reason codes can be recognized by the light emitting elements and so that the appearance of the caller ID device can be fascinated.

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***Regarding claims 3,4,6,7,9,10, 36,37,39,40,42 and 43,*** while Nabkel, Shnier and Lee, as applied above, teach wherein illuminating a first, second and third colored light includes illuminating a yellow, red and blue LED light, Nabkel, Shnier and Lee do not specifically teach of illuminating/flashing a green, yellow, red light in accordance with the three different incoming events, during displaying the caller identification information.

However, Lee teaches that it was well known in the art to have at the LEDs be at least the primary colors so that the user can associate a color with a certain caller ID as shown above in paragraph 18 of Lee. One of ordinary skill in the art would have been motivated to include any color diode that is available so that the incoming call can be illuminated/flashed based upon a color that is more attractive to the user.

The Examiner also notes that it is a matter or design choice to have a certain color represent a certain condition such as caller ID located in the database or caller ID not located in database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Shnier and Lee to include the color of at least green so that the user can recognize the incoming call based upon the color of the LED lights.

***Regarding claims 30 and 44,*** Nabkel in view of Shnier teach wherein displaying a message that no caller identification information associated with the call is available, further includes:

if caller identification information associated with the call is blocked from display, displaying an indication that the call is a private call, (paragraph 35; “Private” is displayed); and



if caller identification information associated with the call is not located during querying a database for caller identification information associate with the call, displaying an indication that the call from an unknown calling area, (paragraph 93, "Out of Area" is displayed).

As discussed above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nabkel by displaying visual indicators based upon the received caller ID as taught by Shnier so that a user can decide, without having to go to read a display, whether to answer a call.

8. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shnier in view of gwmizer@bellsouth.net, Projected Caller ID, (hereinafter gwmizer).

**Regarding claim 47**, Shnier teaches a method of providing visual caller identification, (paragraph 89; LEDs 201,201 and 203 show whether the caller ID information had a reason code; and the device of Shnier displays the name and number of the incoming call), comprising the steps of:

saving a plurality of directory numbers, (paragraph 31);

saving visual information for each of the plurality of directory numbers, (paragraphs 89 and 93; name, number and reason code information is stored);

receiving a call at a caller identification device, (paragraph 92);

querying a database (telephone company records) for caller identification information associated with the call, (paragraph 18);

sending the caller identification information to a caller identification device, (paragraph 93; caller ID is received from the network);

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comparing the directory number associated with the call with the plurality of directory numbers, (paragraph 101);

if one of the plurality of directory number matches the directory number associated with the call, displaying the saved information associated with the directory number onto a display, (paragraphs 54 and 101); and

if one of the plurality of directory numbers does not match the directory number associated with the call, displaying caller identification information associated with the call onto a display, (paragraphs 54 and 98).

While Shnier teaches of displaying the caller identification, Shnier does not specifically teach of projecting the caller identification onto a projection surface.

Gwmizer teaches that it was well known in the art to have a caller ID device that is capable of projecting the caller ID onto a projection surface. Gwmizer teaches that one would have been motivated to project the caller ID a person can be asleep in bed and be able to look up at the ceiling to see who is caller at 2 am, (see description of eBay item).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Shnier by projecting the caller ID onto a projection surface as taught by gmizer so that a user can view the incoming call from a remote surface without having to go to the actual caller ID display.

### ***Response to Arguments***

9. Applicant's arguments filed January 20, 2004 have been fully considered but they are not persuasive.

Applicant contends that gwmizer does not teach projecting information through a projection orifice in the caller identification device and onto a projection surface. The Examiner respectfully disagrees.

As disclosed by gwmizer there are two projection methods for projecting caller identification information onto a projection surface. The first one uses an existing telephone display data and a heads up display projection with florescent lighting and a prismatic lens. The second uses a transparent LCD laser light projection. Both of these methods read on a projection orifice since the caller identification information in the first method goes through an opening which leads up to e.g. the prismatic lens. The second method involves the use of a laser in which laser is projected from the caller identification device. The caller ID device inherently has an opening if the laser is able to send the information onto a projection surface.

Applicant further contends that gwmizer does not satisfy the enablement requirement because a person skilled in the art cannot make and/or use the invention without undue experimentation.

The Examiner does not agree with Applicant's arguments on whether the prior art gwmizer is enabling since the Examiner believes that since the prior art gwmizer clearly teaches each limitation and since the claim is broad enough to read on the conceptualized idea of gwmizer as shown in the Office Action, then a proper rejection can be made.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference provides for implementing the invention for on-hook caller ID messages, which are sent between the first and second power ring signals and before the called party answers the telephone, and off-hook caller ID messages, which are variously called spontaneous caller identification with call waiting, spontaneous call waiting identification (SCWID), visible call waiting, or caller identity delivery on call waiting (CIDCW). Since the secondary reference can provide a user with visual caller identification in multiple caller ID embodiments and specifically caller id with call waiting such as discussed in the primary reference then a proper combination is shown. The motivation as stated above, in the office action, was based on the secondary reference motivation in which one skilled in the art would want to have visually caller ID so that a user can decide, based on illuminating lights and without having to read the caller ID display, whether to answer the incoming call.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante  
Examiner  
Group 2645  
March 22, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

